

(US Patent No. 5,534,927; hereinafter "Shishikui"); claims 3-9, 12-23, and 25-29 are rejected under 35 USC 103(a) on Shishikui in view of Acharya (US Patent No. 5,875, 122; hereinafter "Acharya"); and claims 10 and 11 are objected to and would be allowable if rewritten in independent form.

Reconsideration of the above-referenced patent application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-29 are pending in the above-referenced patent application. No claims have been added or cancelled. Portions of the specification have been amended to provide patent office serial numbers and the like. These minor corrections do not result in the surrender of claim scope or in prosecution history estoppel.

It is noted that several of the patent applications previously cited to the Examiner in an Information Disclosure Statement (IDS) have issued as patents. Therefore, a supplementary IDS providing the relevant information on these issued patents will be provided in the near future.

The Examiner has rejected claims 1, 2, and 24 under 35 USC 102(a) on Shishikui. This rejection of these claims on this basis is traversed.

It is noted that to make a prima facie rejection under section 102 of the patent statute the Examiner must provide a single prior art document that includes each and every element and limitation of the rejected claim or claims. It is respectfully asserted that the Examiner's rejection fails in this regard. For example, claim 1 recites in part:

"...filtering quantized signal samples by applying scaled filter coefficients...so that at the completion of the transform process...at least a selected portion of the transformed signal samples are inverse quantized."

The Examiner points to FIG. 9. However, FIG. 9 depicts a coding or transform process rather than an inverse process. The blocks pointed to by the Examiner relate to aspects of the coding in order to compute the error. Therefore, at the completion of the process, transformed signal samples will not be inverse quantized, as recited in the rejected claim. X

The above is believed sufficient to overcome the Examiner's rejection, although it is believed that there are other limitations in claim 1 that the cited patent also fails to meet. Likewise, claims 2 and 24 either depend from or include similar limitations to claim 1. Therefore, these claims distinguish from the cited patent on at least the same or a similar basis as indicated above regarding claim 1. It is therefore respectfully requested that the Examiner withdraw his rejection as to these claims.

The Examiner has also rejected claims 3-9, 12-23, and 25-29 under 35 USC 103(a) on Shishikui in view of Acharya. This rejection of these claims on this basis is traversed.

It is first noted that it is unclear from the Examiner's Office Action on what basis he believes that the cited Acharya patent (US Patent No. 5,875,122) constitutes prior art. The Examiner is specifically directed to provisions of section 103 that specifically exempt materials that might ordinarily constitute prior art. Therefore, under section 103, materials that are commonly assigned do not constitute prior art for the purposes of that section, if certain other conditions are met, although such materials may nonetheless constitute prior art under specific provisions of section 102. See 35 USC 103 (c). Applicants do not necessarily take the position that this section applies here because it is unclear from the office action on what basis the Examiner is citing the Acharya patent; however, such provisions of 103 may prove to be relevant here and, therefore, the Examiner's attention is directed to them just in case.

Regardless, even assuming, without conceding, that the cited patent might constitute prior art, nonetheless, Applicants believe that the rejection is not proper.

As indicated above, Shishikui fails to meet the limitations of claim 1. Furthermore, Acharya fails to suggest, teach, or describe missing limitations. Therefore, the combination, even if it were proper, which is disputed, would fail to meet the limitations of claim 1. Thus, the combination would also fail to meet at least these missing limitations for any claims that depend from claim 1 and would also fail to meet at least the limitations of any claims where the limitations of those claims are similar to the missing limitations of claim 1, such as those discussed above.

Furthermore, if one of ordinary skill had both Acharya and Shishikui before him or he, he or she would still be unable to produce the subject matter of the rejected claims. The Examiner has not shown otherwise.

For at least the foregoing reasons, the Examiner's arguments regarding the rejected claims are mooted. It is respectfully requested that the Examiner withdraw his rejection of these claims.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 264-0967. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Respectfully submitted,



Howard A. Skaist
Senior Intellectual Property Attorney

Reg. No. 36,008

Dated:

1/2/03

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026
(503) 264-0967

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on:

January 2, 2003
Date of Deposit
Angie C. Farr
Name of Person Mailing Correspondence
Angie C. Farr 1-2-03
Signature Date

MARKED VERSION TO SHOW CHANGES

On page 1, replace the first paragraph with the following:

This patent application is related to concurrently filed U.S. patent application serial no. 09/507, 399, titled "Method of Quantizing Signal Samples of an Image During Image Compression," by Acharya et al., [(attorney docket no. 042390.P7135)] assigned to the assignee of the current invention and herein incorporated by reference.